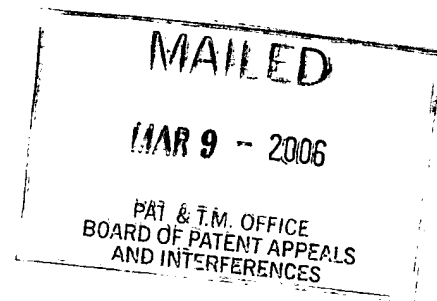


UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte TOMOTOSHI SATO

Application No. 09/668,005



ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER

This application was electronically received at the Board of Patent Appeals and Interferences on January 24, 2006. A review of the application has revealed that the application is not ready for docketing as an appeal. Accordingly, the application is herewith being returned to the examiner. The matters requiring attention prior to docketing are identified below.

A review of the filed indicates that the Appeal Brief filed August 15, 2005 does not fully comply with 37 CFR § 41.37(c).

37 CFR 41.37(c) states:

(c)(1) The brief shall contain the following items under appropriate headings and in the order indicated in paragraphs (c)(1)(i) through (c)(1)(x) of this section, except that a brief filed by an appellant who is not represented by a registered practitioner need only substantially comply with paragraphs (c)(1)(i) through (c)(1)(iv) and (c)(1)(vii) through (c)(1)(x) of this section:

(ix) *Evidence appendix*. An appendix containing copies of any evidence submitted pursuant to §§ 1.130, 1.131, or 1.132 of this title or of any other evidence entered by the examiner and relied upon by appellant in the appeal, along with a statement setting forth where in the record that evidence was entered in the record by the examiner. Reference to unentered evidence is not permitted in the brief. See § 41.33 for treatment of evidence submitted after appeal. This appendix may also include copies of the evidence relied upon by the examiner as to grounds of rejection to be reviewed on appeal.

(x) *Related proceedings appendix*. An appendix containing copies of decisions rendered by a court or the Board in any proceeding identified pursuant to paragraph (c)(1)(ii) of this section.

A review of the application indicates that the following sections are missing from the Appeal Brief of August 15, 2005:

- 1) "Evidence appendix", as set forth in 37 CFR § 41.37(c)(1)(ix); and
- 2) "Related proceedings appendix", as set forth in 37 CFR § 41.37(c)(1)(x).

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Accordingly, the Appeal Brief filed on August 15, 2005 does not comply with the new rules under 37 CFR § 41.37(c). It is required that a supplemental brief be submitted that is in compliance with 37 CFR § 41.37(c). For more information on the Board's new rules see the web page entitled More Information on the Rules of Practice Before the BPAI, Final Rule at:

<http://www.uspto.gov/web/offices/dcom/bpai/fr2004/moreinfo.html>.

Also, on October 25, 2005, the examiner has mailed an examiner's answer. The examiner did not include under the Evidence Relied Upon section, paragraph (8), the listing of references being applied. See MPEP § 1207.02. Before further review, the examiner must submit a corrected examiner's answer that will include the Evidence Relied Upon section with the missing reference being applied.

Accordingly, it is

ORDERED that this application be returned to the examiner to:


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- 1) hold the appeal brief of August 15, 2005 defective;
- 2) request appellants to file a supplemental appeal brief in compliance with 37 CFR § 41.37 or for the examiner to submit a statement regarding the position taken on the missing appendices;
- 3) consider the substitute appeal brief;
- 4) vacate the examiner's answer mailed October 25, 2005, and issue a revised Examiner's Answer having the references being applied listed under the Evidence Relied Upon section, paragraph (8); and
- 5) for such further action as may be appropriate.

It is important that the Board of Patent Appeals and Interferences be informed promptly of any action affecting the status of this appeal (i.e., abandonment, issue, reopening prosecution).

BOARD OF PATENT APPEALS
AND INTERFERENCES

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Application No. 09/668,005

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